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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85708119
Applicant	Dyson Limited
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Date	05/08/2015

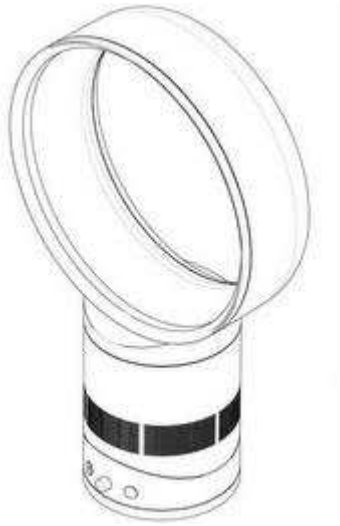
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the application of:

Dyson Limited

Mark:



Serial No.: 85/708,119

Filing Date: August 20, 2012

Trademark Atty: Doritt Carroll

Law Office: 116

NOTICE OF APPEAL

Applicant Dyson Limited hereby appeals to the United States Court of Appeals for the Federal Circuit from the decision of the Trademark Trial and Appeal Board dated March 11, 2015, attached as Exhibit A, denying Applicant's registration on the Principal Register of its trade dress mark for "electric fans; electric freestanding fans; electric fans for personal use; air cooling apparatus" in International Class 11.

Respectfully submitted,

Dated: May 8, 2015

By: /*Jennifer Lee Taylor*/
Jennifer Lee Taylor
Attorneys for Applicant
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EXHIBIT A

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Mailed:
March 11, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dyson Limited

Serial No. 85708119

Jennifer Lee Taylor of Morrison & Foerster LLP for Dyson Limited.

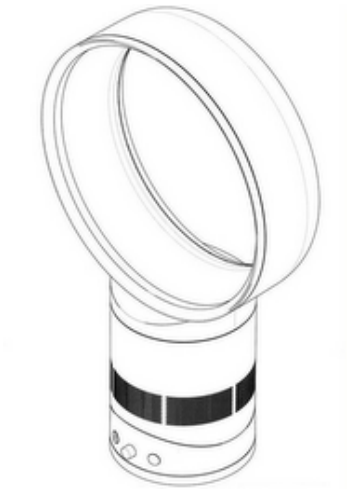
Doritt Carroll, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Taylor, Masiello, and Goodman, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Dyson Limited ("Applicant") applied to register on the Principal Register the mark set forth below for "Electric fans; electric freestanding fans; electric fans for personal use; air cooling apparatus," in International Class 11:[1]

[1] Application Serial No. 85708119, filed on August 20, 2012 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), with a claim of first use and first use in commerce of January 1, 2010. Applicant claimed that its mark has become distinctive of its goods in commerce, as contemplated by Trademark Act Section 2(f), 15 U.S.C. § 1052(f).



The application describes the mark as follows: "The mark consists of a three-dimensional configuration of circular ring on top of a column-shaped base with inlets and buttons. Color is not a feature of the mark. The stippling is a feature of the mark and does not indicate color."

The Trademark Examining Attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that Applicant's proposed mark comprises matter that, as a whole, is functional. When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration. Upon taking up the appeal, the Board, by an order of November 20, 2014 (TTABVUE # 15), remanded the application to the Examining Attorney[2] to consider whether Applicant's mark should be refused registration on the ground that it is a nondistinctive product configuration that has not been shown to have acquired distinctiveness, under Trademark Act §§ 1, 2, and

[2] *See* 37 C.F.R. § 2.142(f)(1) ("If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examiner for further examination to be completed within thirty days.")

45, 15 U.S.C. §§ 1051, 1052, and 1127, in accordance with the guidance of *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1069-70 (2000) (holding that "a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning"). In an Office Action of December 8, 2014 (TTABVUE # 16), the Examining Attorney stated that she had found Applicant's evidentiary demonstration of acquired distinctiveness to be acceptable, and that a refusal on grounds of nondistinctiveness was not warranted. Accordingly, proceedings in this appeal resumed. The case is fully briefed.

The Supreme Court has stated: "In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). A functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995). The Supreme Court confirmed the "*Inwood* formulation" as the "traditional rule" of functionality in *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The functionality doctrine is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court observed in *Qualitex*:

> The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.

> It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

34 USPQ2d at 1164.

The Examining Attorney has the burden of making a *prima facie* showing that the Applicant's mark is functional. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012). The determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *E.g.*, *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009). The Court of Appeals for the Federal Circuit, our primary reviewing Court, looks at the following four factors when it considers the issue of functionality: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *In re Becton, Dickinson and Co.*, 102 USPQ2d at 1377, *citing Valu Eng'g*, 61 USPQ2d at 1426 and *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). These well-known "*Morton-Norwich* factors" are "legitimate source[s] of evidence to determine whether a feature is functional." *Valu Eng'g*, 61 USPQ2d at 1427. However, the Supreme

Court has made it clear that the standard for functionality is set forth in *Inwood*, *i.e.*, whether a feature is "essential to the use or purpose of the device or… affects the cost or quality of the device," and that if functionality is properly established under *Inwood*, further inquiry into facts that might be revealed by a *Morton-Norwich* analysis will not change the result. *TrafFix*, 58 USPQ2d at 1006 ("Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.").

1. Applicant's product.

Applicant's product is an electric fan that Applicant characterizes as "bladeless." Two examples of the product are pictured below:

See Application at 25, 37. In order to address the Examining Attorney's refusal on grounds of functionality, some explanation of how the fan works is in order.

The fan is not truly bladeless. The cylindrical base of the product conceals a fan or "impeller" (which has blades), whose purpose is to give movement to air that enters the base through air inlets (perforations arranged in a band around the circumference of the base, as seen above and in the drawing of the mark). The impeller pushes air up into the body of the circular ring shown in the mark, which Applicant refers to as a "nozzle." Near the back of the nozzle, a narrow slit or "mouth" runs along the inner surface of the nozzle, presumably along its entire circumference. (The mouth is not visible in the drawing of the mark.) The mouth emits the air so that it flows forward along the inner surface of the nozzle. The inner surface of the nozzle has a particular contour, designed to function somewhat in the manner of an airfoil. (Although the inner surface of the nozzle is visible in the drawing of the mark, the contour of the inner surface is not a visible element of the mark.) The intended effect of the emission of the air from the mouth and its forward flow over the airfoil is to create a physical effect whereby air behind the nozzle is drawn forward through the empty circular space defined by the nozzle.[3] This secondary air flow combines with the air emitted from the mouth to amplify the amount of air that is projected toward the user, creating the desired cooling effect.

2. Relevant patents of Applicant.

The nature of Applicant's product is illustrated by a number of utility and design patents and utility patent applications that Applicant has made of record:

[3] In the patent materials of record, this effect is sometimes referred to as a "Coanda effect."

Utility patents:[4]

7931449 B2
8308445 B2
8403650 B2
8348629 B2
7972111 B2

Utility patent applications:[5]

Serial No. 12/203698 (Pub. No. US2009/0060710 A1)
Serial No. 12/230613 (Pub. No. US2009/0060711 A1)
Serial No. 12/945558 (Pub. No. US2011/0058935 A1)
Serial No. 12/716749 (Pub. No. US2010/0226787 A1)
Serial No. 13/314974 (Pub. No. US2012/0082561 A1)

Design patents:[6]

D602143 S

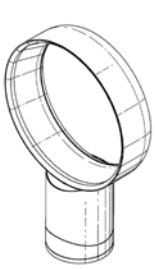


FIG. 1

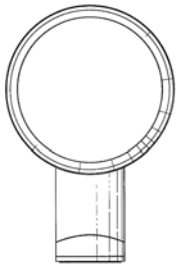


FIG. 2

D605748 S

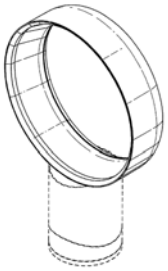


FIG. 1

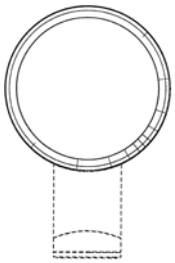


FIG. 2

[4] Request for reconsideration, Declaration of Jennifer Lee Taylor, Exhibits C-F and K, 5 TTABVUE 190-245, 306-326.

[5] *Id.*, Exhibits L and G-J, 5 TTABVUE 327-337, 246-305.

[6] *Id.*, Exhibits M and N, 5 TTABVUE 338-349. We have reproduced only two of the illustrative figures from each design patent to show the similarity between Applicant's mark and the designs in the two patents.

As we discuss below, Applicant and the Examining attorney disagree as to what the patent materials indicate with respect to the alleged functionality of the product's design. Further illuminating the significance of the patents are certain findings in federal District Court litigation relating to Applicant's design patents. We will discuss each in turn.

(a) The Examining Attorney's position.

The Examining Attorney contends that Applicant's utility patents demonstrate the utility of each visible aspect of Applicant's mark. In several of the patents, she points to claims that describe the invention as having a nozzle that "comprises a loop," or "is substantially annular," or "is at least partially circular." (*See, e.g.*, Patent No. 7931449, claims 8, 9, and 10.) She contends that these claims illustrate the functionality of the circular shape of the nozzle and its form as a continuous loop, through which the air moves.

Similarly, with respect to the cylindrical shape of the base, she points to claims describing the invention as a fan "wherein the base is substantially cylindrical" and contains an impeller housing, within which is a motorized "impeller to create an air flow through the impeller housing." (Patent No. 7972111, claims 4 and 1.) She contends that since the impeller blades "rotate in a circle, a cylindrical housing, or base, is the most efficient form to contain them."

With respect to the placement of the air inlets on the base, the Examining Attorney contends that their placement "is dictated by the impeller assembly"; that the inlets must be opposite the nozzle (*i.e.*, at the bottom of the base) so that the

impeller, which will move the air, will stand between the air inlet and the nozzle. She also points to patent application 2009/0060711 A1, which explains that "[l]ocating air inlets around the base provides flexibility in the arrangement of the base and the nozzle, and enables air to flow into the base from a variety of points thereby to enable more air to flow into the assembly as a whole."

Regarding the three lines that circle the base, the Examining Attorney argues that they are "artifacts of additional utilitarian features of the fan." The upper line, she contends, "indicates an oscillating portion of the base." We note that Application 2010/0226787 A1 states that "The fan assembly preferably comprises means for oscillating the nozzle so that the air current is swept over an arc…." The middle, "slightly hyperbolic" line, she contends, "is an artifact of the tilting feature of the fan." We note that in Patent No. 7972111, figures 5(a), (b) and (c) illustrate the manner in which the base may be tilted, and the summary of the invention states, "the upper base member **42** is moveable relative to the intermediary base member **40** and the lower base member **38** of the base **12** between a first fully tilted position, as illustrated in FIG. 5*(b)*, and a second fully tilted position, as illustrated in FIG. 5*(c)*." The relationship between the tilting function and the "hyperbolic" line is illustrated by the pictures below, showing Applicant's fan in such a tilted position:[7]

[7] Office Action of July 15, 2013 at 24.

The line near the bottom, the Examining Attorney contends, "is merely indicative of a connection between the lower base member and the upper base member."[8]

As to the three buttons near the bottom of the base, the Examining Attorney argues that "Every electrical device must have an on/off switch of some type. … [T]hey perform the simple utilitarian function of allowing the device to be activated." Indeed, Patent No. 7972111 states, "The base preferably comprises control means for controlling the fan assembly. For safety reasons and ease of use, it can be advantageous to locate control elements away from the nozzle so that the control functions, such as, for example, oscillation, tilting, lighting or activation of a speed setting, are not activated during a fan operation."

[8] We note that Patent No. 7972111 indicates that the base is, in fact, composed of "a lower base member **38**, an intermediary base member **40** mounted on the lower base member **38**, and an upper base member **42** mounted on the intermediary base member **40**." Thus, contrary to what the Examining Attorney says, it would be more correct to suggest that the bottom line indicates the juncture of the lower base member and the *intermediary* base member.

(b) Applicant's position.

Applicant, for its part, points out that "trade dress must be analyzed *as a whole*, and not by its individual elements." Applicant contends that the Examining Attorney has dissected Applicant's trade dress, and "has converted the trade dress into a checklist of design concepts…."[9] Applicant's Group IP Director has stated that "Dyson does not own any utility patents, or applications for utility patents, whose claims are directed to the utilitarian advantages of the applied-for design as a whole" and that "[t]he shapes of the various elements [of the design] are not dictated by function."[10]

With respect to the circular, annular, or loop shape of the nozzle, Applicant argues that the language of the patents "could encompass a variety of shapes, such as an oval or egg shape"; and that "[a] loop is not necessarily a circular ring; it is any curved shape that bends around and crosses itself so that it is closed."[11] Applicant contends that "the circular ring shape is an incidental feature of the design, and that a variety of design options can achieve the principal teachings of the patent."[12] Applicant points out that several of the patents state that "Other shapes of nozzle are envisaged. For example, a nozzle comprising an oval, or 'racetrack' shape, or a single strip or line, or block shape could be used." *See* Patent No. 8308445 B2. Applicant points out that the inventor of Applicant's fan testified,

[9] Applicant's brief at 1-2, 7 TTABVUE 5-6.

[10] Declaration of Gillian Ruth Smith, ¶¶ 3,4, filed with Applicant's response of June 20, 2013, pp. 17-22.

[11] Applicant's brief at 4, 7 TTABVUE 8.

[12] *Id*. at 5, 7 TTABVUE 9.

in litigation to enforce a related design patent, "that one alternate design included a nozzle that was oval-shaped on the inside but rectangular on the outside, and that the 'outside doesn't affect the function of the internal nozzle.'"[13]

With respect to the cylindrical base, Applicant points out that patent application 2010/0226787 states that "the profile of the outer surfaces of the base and the body may be substantially circular, elliptical, or polyhedral." Applicant argues that "different designs can offer more or different functionalities than the applied-for design. For example, the whole base unit could be proportionally larger with a greater diameter, which would increase the stability of the fan…. Thus, the column-shaped base with the proportions shown in the applied-for trade dress is an ornamental, not utilitarian, feature of the design."[14]

Regarding the air inlets, Applicant argues that "no utility patent discloses the particular arrangement of inlets in a series of rectangular blocks shown in the applied-for trade dress"; and that "[t]he series of rectangular blocks which form the pattern of air inlet holes … were selected at least in part for aesthetic reasons."[15]

As for the buttons, Applicant argues that their function of activating the device

> does not mean their appearance … is not ornamental. Here, the buttons are circular, echoing the shape of the top portion of the fan, and two buttons are recessed into the base of the fan so that they are flush with the rest of the surface of the base. This emphasizes the sleek,

[13] Applicant's brief at 5-6, 7 TTABVUE 9-10. *See also* Declaration of Jennifer Lee Taylor, Exhibit B, transcript of Preliminary Injunction Hearing in *Cornucopia Products, LLC v. Dyson Technology Limited*, Case No. 2:12-cv-002340-NVW (D. Ariz., July 12, 2012), 5 TTABVUE 52-189 at 69.

[14] Applicant's reply brief at 6, 12 TTABVUE 10.

[15] *Id*. at 6-7, 12 TTABVUE 10-11.

> uncluttered look of the overall design. The utility patents and patent applications cannot and do not claim any functional purpose for this specific array of buttons.[16]

Overall, Applicant emphasizes that even if individual elements of Applicant's trade dress are shown to have a function, the overall combination of such elements, when considered as a whole, does not meet the standard for functionality under Trademark Act § 2(e)(5).

(c) Findings in earlier litigation.

In support of its position, Applicant has submitted substantial portions of the record in the case of *Cornucopia Products, LLC v. Dyson Technology Limited*, Case No. 2:12-cv-002340-NVW (D. Ariz., 2012), in which Applicant sought and obtained a preliminary injunction against infringement of its trade dress on the basis of its design patents D605748 and D602143. Although Applicant admits that "the standard for functionality of design patents is different than the standard for trade dress functionality," it argues that "the Court's analysis is illustrative here."[17] We agree, because in that case the Court considered a direct challenge to the designs shown in Applicant's design patents on grounds of functionality and performed a detailed analysis of the same. Notably, in determining whether Applicant had demonstrated a likelihood of success on the merits, the Court found that virtually every element of the designs was functional; nonetheless, the Court found that Applicant could rely upon the specific proportions of its design. In issuing its preliminary injunction, the Court stated:

[16] *Id*. at 7, 12 TTABVUE 11.

[17] Applicant's brief at 8, 7 TTABVUE 12.

> With respect to design patents, infringement comes down to whether, "in the eye of an ordinary observer, giving such attention as a purchaser usually gives … [the] resemblance [between the claimed design and the accused product] is such as to deceive such an observer, inducing him to purchase one supposing it to be the other."

Cornucopia Products, Order of July 27, 2012, at 10-11,[18] *quoting Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (ellipsis and paraphrases in original).

We note in particular the Court's findings regarding the following features of Applicant's design.

The nozzle's circularity:

> "[I]t cannot be disputed that a circle is the only design that will achieve the sort of air discharge pattern and effectiveness normally associated with a table fan. … It is unworthy of belief to say that this was purely an aesthetic, ornamental choice.
>
> "In addition, the '449 utility patent claims circularity in its dependent claims, … claims 8-10, as does the '166 utility patent, … claims 7-9, 18, 22-24. Whether that claim is valid or invalid, it concedes functionality of the circle and precludes a design patent on the same feature."

The nozzle's depth:

> "On cross examination, Gammack[19] testified that reducing the depth of the nozzle by half 'might affect' air flow and velocity. … However, the fact that Dyson's nozzle has depth downstream from the air discharge slit is certainly functional. It is necessary to Dyson's claim to have harnessed the Coanda effect to improve airflow. Even if the Coanda effect is illusory, the nozzle's depth reduces peripheral diffusion in favor of airflow in the axis and the plain of the nozzle. It is likely that a bladeless fan nozzle with little or no depth (as in the Japanese patent) would be less effective than a

[18] 5 TTABVUE 39-40.

[19] Peter David Gammack identified himself as concept design director of Dyson Technology Limited. He is listed as an inventor on many of the utility patents of record.

	nozzle with a few inches of depth (as in Dyson's design). Indeed, the addition of such depth – through a 'diffuser' – is one of the ways in which Dyson's '499 utility patent claims to differ from the prior art. Thus, the D143 and D748 patents do not appropriately claim *any* nozzle with depth."
The outer surface of the Nozzle:	"At this stage of the proceedings and the evidence, the Court is not persuaded that performance would be unaffected by a different design on the outer surface and outer curve. For example, if the outer surface dipped inward (rather than bulged outward), thus creating a "pinch" within the nozzle, undesirable air pressure effects might result. An outer bulge in the surface of the ring would increase the interior volume of the nozzle and the air to be driven through it, which could dissipate some of the fan's energy in compressing air in dead space rather than driving it through the discharge ring with maximum force. For many customers, a bulkier nozzle would reduce convenience, especially on a surface, like a table or desk, shared with other objects. "The outer and inner curves directing airflow to the air discharge slit are also functional. Together, their appearance discloses the function they perform. A competitor need not disguise obvious function, and the design patentee cannot own the look of function."
The shape of the base:	"The function of the base is as a platform for the concealed fan that draws air from around the base and forces it into the nozzle for discharge. Since exposed fan blades are an obvious safety hazard, some sort of housing is necessary. And since the fan blades rotate in circular fashion, any sort of housing will, at a minimum, be cylindrical. "The cylindrical shape of such housing is not just one among many equally useful shapes. Rather, function requires cylindrical housing of the fan, or air and pressure would be lost between the blades

> and the housing. Thus, Gammack was right that numerous designs could accommodate the impeller and ducting inside the base without changing the fan's performance or stability – but only in the sense that the operating internal cylindrical shape could be hidden with an additional external covering of any shape. The question here is whether Dyson can monopolize the look of a cylindrical form that is functional. The answer in general is no. The look of a cylinder is not arbitrary or decorative; it is the look of operation. … Accordingly, the D143 patent does not appropriately claim all circular bladeless fan bases."

Id. at 13-16, 5 TTABVUE 42-45.

The District Court, after remarking that "each portion of the design and its combination with other portions appears to have a functional purpose," nonetheless found that "the proportions of the various components in relation to each other is ornamental," *id*. at 16, 5 TTABVUE 45, and that "The D143 patent appropriately claims a bladeless fan design with a cylindrical base of a certain diameter and height in proportion to a ring-shaped nozzle of a certain diameter and depth." *Id*. at 17, 5 TTABVUE 46. Because the District Court deemed the proportions of the design to be worthy of design patent protection, and because Cornucopia's design precisely mimicked such proportions, it found for purposes of the motion for a preliminary injunction that Applicant was likely to succeed on the merits because it was "likely to persuade the trier of fact that the 'ordinary observer' would consider Cornucopia's fan materially indistinguishable from the D143 design." *Id*. at 17-18. *See* 5 TTABVUE 46-47.

We give substantial weight to the District Court's findings as to the functionality of certain features of Applicant's design, inasmuch as the Court had the benefit of adversarial argument by interested and knowledgeable parties as well as live testimony at hearing, including the testimony of one of the inventors of Applicant's invention; and because the standard for functionality applied by the Court is substantially similar to the standard of functionality applicable to the case before us. We note, however, that the Court's finding as to the protectability of the proportions of Applicant's design is based upon standards that differ from those that guide us in determining the protectability of Applicant's design as a trademark. As the Court made clear, infringement of a design patent occurs where the resemblance between two designs is such that an ordinary observer would "purchase one [product] believing it to be the other." 5 TTABVUE 39-40. Trademark infringement occurs where a customer would be likely to confuse the *source* of one product with the source of another. If Applicant obtains the desired trademark registration, Applicant would be in a position to enforce it not only against those who imitate the design in its precise proportions, but also against users of any design so resembling Applicant's design as to be likely to cause confusion, mistake or deception. Accordingly, the District Court's finding on this point does not dispose of the question before us, because a trademark registration could provide, possibly in perpetuity, a substantially broader scope of protection than the District Court contemplated extending to Applicant.

3. The Existence of Patents

The utility patents and other patent-related materials of record indicate that each of the visible elements of the design that Applicant seeks to register is functional. The claims set forth in the utility patents, together with the findings of the District Court and the evidence before the Court in the *Cornucopia* case, persuade us that the circularity of the ring-shaped nozzle (including the inner and outer surfaces of the nozzle) and the cylindrical shape of the base are functional. Because of the unique geometric characteristics of the circle, it is the most efficient shape for the cross-section of the base (in which a bladed impeller rotates in a circle) and for maximizing the central discharge area of the nozzle, through which the air is to be discharged toward the user. The three lines are essential to the tilting function and the oscillating function of the fan, and to the intended multi-part construction of the base. The array of intake vents encircling the entire base increases efficiency by allowing air to enter the device from any direction. The array of three control buttons in a straight line is one of only a few superior arrangements: if the buttons were widely separated, or scattered randomly over the base, a user would have difficulty finding them and remembering which one controls which function. Similarly, the circular shape of the buttons, which is highly conventional, is one of a few superior shapes for buttons, and making them in a different, more distinctive shape most likely would entail added expense of design and manufacture. Overall, we find that the first *Morton-Norwich* factor favors a finding of functionality.

4. Touting of functionality.

The Examining Attorney, addressing the second *Morton-Norwich* factor, argues that Applicant's own advertising touts the utilitarian advantage of its trade dress. The evidence on this point is not persuasive. Although Applicant's advertising includes statements such as "Airflow is accelerated through an annular aperture";[20] and "Air Multiplier technology generates smooth, uninterrupted airflow by using an annular jet to draw in surrounding air and multiply it up to 15x,"[21] these statements do not actually say that the annular shape of the aperture or the jet is what causes the acceleration of airflow. Similarly, the third-party explanations of how the product works discuss the circularity of the nozzle primarily as a matter of fact, rather than as the explanation for why the product functions. *See, e.g.*, "Dyson's Bladeless Fan: Worth the Hefty Cost?," *Time*, October 21, 2009[22] ("The air rushes out of tiny, millimeter-long slots that run along the circular frame and flows down a gently sloping ramp. As the air emerges from the ramp, it creates a circular low pressure region that pulls in the air from behind creating a fairly uniform flow of air through the ring.")[23] Accordingly, on this record we see no touting as contemplated by *Morton-Norwich*.

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[20] Final Office Action of July 15, 2013 at 10.

[21] *Id*. at 29. We note that this advertisement appears on a Staples website and does not necessarily reflect a claim of Applicant itself.

[22] *Id*. at 20.

[23] We note Applicant's objection that "the second *Morton-Norwich* factor requires analysis of the Applicant's *own* advertising, not statements by third parties…." Applicant's brief at 10, 7 TTABVUE 14. The guidance of *Morton-Norwich* does not require us to close our eyes to any particular form of evidence, if it is probative. An applicant's own advertising is generally particularly probative, since an applicant can be expected to be knowledgeable

5. Availability to competitors of functionally equivalent designs.

The third *Morton-Norwich* factor is whether "there are other alternatives available," because "the effect upon competition 'is really the crux of the matter.'" 213 USPQ at 16. Applicant characterizes the relevant inquiry as "whether or not competitors need the Applicant's design to effectively compete," and contends that there is already a "plethora of alternative designs on the market" which "make clear that Applicant's applied-for trade dress is far from the only viable design for a bladeless electric fan."[24] Some of the examples of such alternative designs are shown below:[25]

about its own product. Nonetheless, third parties may also have persuasive, even authoritative, insights into issues of technology; if evidence of their views is reliable and probative, it may be considered.

[24] Applicant's brief at 10, 7 TTABVUE 14.

[25] Applicant's response of June 20, 2013 at 37-49.

The question we must consider is whether alternative designs exist that would permit a competitor to manufacture a bladeless fan that, compared to Applicant's product, works "equally well." *Valu Eng'g*, 61 USPQ2d at 1427, quoting with approval J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §7:75, 7-180-1 (4th ed. 2001). If competitors cannot do so without copying Applicant's design, then the design would be "essential to the purpose" of the fan, as contemplated by *Inwood*. If variations from the design of Applicant would alter the functional qualities of a competitor's goods, then it would be clear that the design "affects the … quality of the article." *See Inwood*, 214 USPQ at n.10; *TrafFix*, 58 USPQ2d at 1006. In such circumstances, to issue a trademark registration covering Applicant's design would frustrate the policies of patent law

whereby, upon the expiration of Applicant's utility patents, competitors should be free to practice the invention.

On the present record, we do not find variations on Applicant's design, such as those shown above, to be functionally equivalent. Some of those designs have a circular nozzle with variations on the outer surface of the nozzle (such as sculptural elements resembling ears or earphones). However, the District Court in *Cornucopia* found the outer surface of the nozzle to be functional inasmuch as any variation affecting the shape of the airway would affect the efficiency of the device. A competitor could, of course, make a nozzle whose airways are identical to those of Applicant, while disguising that fact by altering the shape of the outer housing of those airways. But the Supreme Court made clear in *TrafFix* that when competitors copy a functional feature of a design, they must not be required to hide or disguise the functional feature beneath a different design:

> Because the dual-spring design is functional, *it is unnecessary for competitors to explore designs to hide the springs*, say by using a box or framework to cover them as suggested by the Court of Appeals. (Citation omitted.) The dual-spring design assures the user the device will work. … It would be … something of a paradox, were we to require the manufacturer to conceal the very item the user seeks.

58 USPQ2d at 1007 (emphasis added). Those alternative designs having sculptural "ears" or "earphones" added to the outer surface of the nozzle illustrate the kind of hiding of function that the Supreme Court has said is unnecessary.

The same can be said of those designs in which the cylindrical base of Applicant's design has been altered so as to resemble the body of a person, a teddy bear, or a

snowman; or has been altered into the shape of a rocket ship; or in which the base is otherwise flared or tapered. The District Court in *Cornucopia* explained its finding that a cylindrical housing was optimal. ("[F]unction requires cylindrical housing of the fan, or air and pressure would be lost between the blades and the housing.")[26] We find this reasoning persuasive. Accordingly, a design in which the base is differently shaped is not a functionally equivalent alternative.

With respect to those alternative designs in which the nozzle is not circular, we note the District Court's finding that the circularity of Applicant's nozzle was functional, inasmuch as it was claimed in Applicant's '449 utility patent; and because "it cannot be disputed that a circle is the only design that will achieve the sort of air discharge pattern and effectiveness normally associated with a table fan."[27] It is also well established that a circle encloses the largest area of all geometric shapes of equal perimeter. Accordingly, a circular nozzle maximizes the discharge area of the fan, and any fan having a nozzle with a non-circular shape of the same perimeter would have a smaller discharge area than that of Applicant (adversely affecting its function). We therefore do not consider the fans having non-circular nozzles to be functionally equivalent alternatives. On the present record, this *Morton-Norwich* factor favors a finding of functionality.

6. Simplicity or cost of manufacture.

We next consider whether the design of Applicant's product results from a comparatively simple or inexpensive method of manufacture. Applicant contends

[26] *Cornucopia*, order at 16, 5 TTABVUE 45.

[27] *Id*. at 14, 5 TTABVUE 43.

that it does not. Applicant's Group IP Director stated that "Dyson's electric fans are specially manufactured from customized parts; as a result, these fans are not cheaper or easier to manufacture compared to other products."[28] However, the record casts doubt on the suggestion that manufacture of Applicant's design is necessarily costly. The *Cornucopia* litigation arose from a situation in which "Cornucopia's fan was obviously created to provide consumers with almost exactly the same overall appearance, but at a much lower price." According to the District Court, the Cornucopia product was offered at a retail price less than a third that of Applicant's product.[29]

The Examining Attorney points to two of Applicant's patents which state, respectively, that where "the nozzle is at least partially circular" or where the interior passage of the nozzle "is continuous," "[i]n this arrangement the nozzle can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs."[30] We do not give weight to these two patent disclosures because the continuity of an interior passage is not something that can be seen in the design that Applicant seeks to register; and the Examining Attorney has not shown exactly how the claim of "partial" circularity relates to the design at issue.

Nonetheless, the fact that Applicant's proposed mark consists of fundamental geometric forms, *i.e.*, the circle and the cylinder, strongly suggests that the design

[28] Declaration of Gillian Ruth Smith ¶ 9, Applicant's response of June 20, 2013 at 21.

[29] *Cornucopia*, Order at 18, 5 TTABVUE 47.

[30] Patent 7931449 B2, col. 3 l.65-col.4 l.4, 5 TTABVUE 200; Patent 8403650 B2, col. 3 l.66-col. 4 l.3, 5 TTABVUE 228.

has a degree of simplicity, the avoidance of which would place competitors at a disadvantage. If competitors must eschew the efficiencies of the circle and the cylinder, discussed above, in order to avoid infringement of Applicant's mark, it seems probable that they will be put to added expense. The requirement that competitors design more complex forms, distinct from the circle and the cylinder, appears likely to place upon them extra design costs. Similarly, the need to eschew round control buttons arrayed in a straight line, or to design air inlets that do not resemble Applicant's rectangular inlets, would likely increase the design costs of a competitor. While we cannot, on this record, make definitive findings as to the costs of manufacture faced by either Applicant or its competitors, we find that this factor weighs somewhat in favor of a finding of functionality.

7. Conclusion.

The ultimate question that we must address is whether Applicant's mark "comprises any matter that, as a whole, is functional." 15 U.S.C. § 1052(e)(5). Applicant points out that the utility patents of record do not reflect every aspect of the design that Applicant seeks to register and that "none of them discloses the utilitarian advantages of the trade dress as a whole."[31] Applicant argues that "[r]ather than considering the overall design, the Examining Attorney dissected the applied-for trade dress into distinct design elements and attributed a utility to each

[31] Reply brief at 1, 12 TTABVUE 5.

based upon isolated statements from one of Applicant's utility patents or utility patent applications."[32]

Our principal reviewing Court has stated that "a mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional." *In re Becton, Dickinson*, 102 USPQ2d at 1376. The Court explained, "Whenever a proposed mark includes both functional and non-functional features, as in this case, the critical question is the degree of utility present in the overall design of the mark." With reference to *Textron, Inc. v. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625 (Fed. Cir. 1985), the Court said, "*Textron* instructs that where a mark is composed of functional and non-functional features, whether 'an overall design is functional should be based on the superiority of the design as a whole…'"

As we have discussed above, three of the *Morton-Norwich* factors favor a finding of functionality: the patent materials of record; the lack of functionally equivalent alternative designs; and the apparent additional complexity and cost of manufacturing a product in a different design. For the reasons discussed in this decision, we are convinced that all of the visible elements of Applicant's design are functional and that their combination results in a design that is, as a whole, functional within the meaning of Section 2(e)(5). The general shapes of the nozzle and the base are determined by the function of the product; and the record indicates that their specific circular and cylindrical shapes are indeed more efficient than

[32] *Id*. at 1-2, 12 TTABVUE 5-6.

alternative shapes. The control buttons and air inlets are also functional; their shapes and the manner in which they are arrayed on the base are among only a few superior arrangements. To the extent that one could say that the shapes or arrays of the buttons and air inlets are non-functional in any way, we find that they constitute "insignificant elements of the design" which cannot render the design as a whole protectable. In this regard, we note that Applicant itself did not include the buttons or air inlets as part of the design for which it sought design patent protection.

Viewing the record in its entirety, we find that the design of Applicant's product comprises matter that, as a whole, "is essential to the use or purpose of the article or … affects the cost or quality of the article," as contemplated by *Inwood*. We therefore find that Applicant's product design is functional within the meaning of Section 2(e)(5).

Decision: The refusal to register is affirmed.